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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,326	11/17/2003	Samuel C. Wadsworth	5062CIP	7027

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GENZYME CORPORATION
LEGAL DEPARTMENT
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EXAMINER

CHANDRA, GYAN

ART UNIT PAPER NUMBER

1646

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/716,326	WADSWORTH ET AL.	
	Examiner	Art Unit	
	Gyan Chandra	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☐ Claim(s) 14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/9/04; 12/5/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II, claims 14-16 with further election of amino acid sequence of SEQ ID NO: 4 in the reply filed on 12/05/2005 is acknowledged. The traversal is on the ground(s) that the examination of 10 amino acid sequences does not constitute an undue burden on the Examiner or to the Office. Applicant states that examining amino acid sequences is relatively uncomplicated and therefore the Office should consider at least 10 amino acid sequences. This is not found persuasive because each nucleic acid sequence and polypeptide sequence is a distinct invention. Protein sequence databases comprise many databases including patent databases and public amino acid databases. Each amino acid sequence requires a separate and unique search. Each polypeptide requires the search of nine different databases. If the Examiner were to search 10 polypeptides, 90 separate searches would be required. Because of this searching for more than one amino acid sequence would impose a serious search burden.

Applicant's correction to the previous restriction requirement where Group II was inadvertently reversed with Group III, is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

Status of Application, Amendments, And/Or Claims

Claims 1-22 are pending.

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Claims 1-13 and 17-22 are withdrawn from further consideration as being drawn to a nonelected Invention.

Claims 14 -16 are examined on the merit to the extent that they read on the elected amino acid sequence of SEQ ID NO: 4.

Information Disclosure Statement

The information disclosure statement filed 04/09/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the crossed references from line 19 "WO 95/06743" through line 26 "WO 99/57296" therein have not been considered.

Applicants may, in response to this and no later Office Action, submit the missing references. Such submissions will be considered to have been part of the respective Information Disclosure Statement filed on 04/09/2004, and the PTO-1449 will be updated accordingly. No fee for the submission of such references is required, nor should applicants file an additional form PTO-1449 with the missing references.

Specification

The use of the trademark on page 17, line 27 has been noted in this application. It should be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Selden et al (U.S. Patent No. 5,994,127).

The claim is drawn to an isolated precursor glucagon-like peptide 1 (GLP-1) comprising mammalian GLP-1 linked to a heterologous signal sequence.

Selden et al teach making a nucleic acid construct comprising a heterologous sequence of human growth factor signal sequence at the N-terminus to human GLP-1 and expressing GLP-1 (col. 22 –24). They state that a fusion protein can be made using the signal peptide of the LDL receptor, preproglucagon or human growth factor (see column 23, lines 16-24). The skill of the art describes a “precursor” as a pre form of a protein which upon cleavage of a leader sequence such as signal sequence results in the mature protein. Therefore, all the limitations of the instantly claimed invention are met.

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Claim 14 is objected to as being dependent upon non elected claim 12, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 16 is objected to as being dependent upon a rejected base claim 15, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

No claim is allowed.

The precursor GLP-1 of SEQ ID NO: 4 is free of prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gyan Chandra whose telephone number is (571) 272-2922. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 1646
27 January 2006
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EILEEN B. O'HARA
PATENT EXAMINER